

### **REMARKS**

Claims 14 and 40-51 have been canceled herein. Such cancellation is **without** prejudice on the merits and subject to the Remarks provided below. Applicant intends to file a continuing application drawn to the subject matter of Claims 14 and 40-51.

Claims 13 and 52 have been amended herein.

Claims 13, 15-39, and 52-55.

#### **Finding of Non-Responsiveness:**

Applicant strenuously traverses the Office's assertion that his prior reply was not fully and completely responsive to the earlier Official Action. Contrary to the assertion made in the Notice dated April 5, 2004, Applicant **did not** receive an Office Action on the merits for detecting BSE. Rather, as is clearly and unambiguously stated at page 3 of the earlier Office Action, the Office explicitly noted that "The claims are drawn to a diagnostic test for spongiform encephalopathy [not just BSE] **and other demyelinating conditions in mammals.**" Emphasis added. The Office explicitly objected to the highlighted term not for being drawn to unelected subject matter (there has been no restriction in the case), but under 35 USC §112, first paragraph.

Thus, Applicant's prior response, which deleted the offending phrase "and other demyelinating conditions in mammals," and inserted in its place "multiple sclerosis," was directly and fully responsive to a rejection explicitly made on the record. In short, the Office objected to the original phrase as being impermissibly broad in light of the specification, and Applicant responded by inserting the more definitive ailment, multiple sclerosis (which has verbatim support in the specification). In light of the Office's position articulated in the earlier Office Action, Applicant respectfully submits that his prior response was therefore a full and complete response to each and every point raised by the Office. Applicant therefore traverses the non-responsive holding as being clearly improper.

That being said, Applicant's undersigned counsel appreciates the thoughtful conversation held between counsel and Examiner Navarro. The issue at hand is that the pending Office Action amounts to a restriction requirement, *sub rosa*. As noted previously, there is currently no restriction requirement in the case. Nor did the Office or

the Applicant himself explicitly or implicitly limit the claims to BSE, as stated in the pending Office Action (*e.g.*, as by original presentation). Claim 1 as originally filed clearly recited "spongiform encephalopathy and other demyelinating conditions."

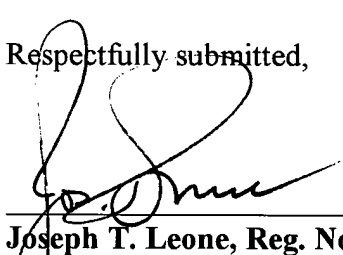
In the interests of compact prosecution, however, the claims as amended herein have been limited to "spongiform encephalopathy." The claims drawn specifically to MS have been cancelled from the case. Applicant requests entry and consideration of the claims as amended herein.

To make the record crystal clear, the subject amendment to the claims is without prejudice to further prosecution of the canceled subject matter in one or more continuing applications. Additionally, Applicant requests that his arguments and Rule 132 Declaration submitted in his prior response be entered and considered on the merits.

#### CONCLUSION

Applicant submits that the application is now in condition for allowance. Early notification of such action is earnestly solicited.

Respectfully submitted,



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Certificate of Mailing: I hereby certify that this Response and the papers indicated as being transmitted herewith is being deposited with the United States Postal service on Monday, June 7, 2004, in an envelope addressed to the Commissioner for Patents, **MAIL STOP: FEE**, P.O. Box 1450, Alexandria, VA 22313-1450.



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Joseph T. Leone, Esq.

June 7, 2004  
Date: June 7, 2004